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**DIRECTOR OFFICE
TECHNOLOGY CENTER 2600**

In re Application of:
Pradeep Sindhu, et al.
Application Serial No.: 09/448,124
Filed: November 24, 1999
For: **SWITCHING DEVICE**

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**DECISION
ON PETITION**

This is a decision on the petition filed August 28, 2003, under 37 CFR § 1.144 requesting withdrawal of the restriction requirement initially issued by the examiner on January 14, 2003; traversed by applicants in a response filed February 11, 2003; and maintained by the examiner in an Office action dated May 28, 2003. This decision is also responsive to the amendment and response filed August 28, 2003.

BACKGROUND

A restriction requirement (paper # 9) was mailed on January 14, 2003 setting forth restriction between four groups of invention.

A response to the restriction requirement (paper # 11) was timely filed and received in the Patent and Trademark Office (PTO) on February 11, 2003, wherein applicants elected to prosecute the claims of Group I with traverse. Applicants argued in the response that all of the claims in Groups I through IV are directed to a switching device and are not patentably distinct for the reasons provided by the examiner.

A non-final Office action (paper # 12) was mailed on April 15, 2003; wherein the Office action failed to address attorney's arguments directed to the restriction requirement.

An interview summary between the examiner and the attorney of record was conducted on May 15, 2003 (paper # 16, attached as part of paper # 15). The attorney of record requested a new Office action which addressed the arguments made against the restriction requirement. The examiner agreed to send a new Office action.

A new Office action (paper # 15) was mailed on May 28, 2003, wherein the new action addressed the attorney arguments and repeated the former restriction requirement and made it Final.

Petitioner seeks relief by filing the instant petition (paper # 17) under 37 CFR § 1.144 requesting that the restriction requirement be withdrawn. An amendment and response were also filed with the August 28, 2003 petition.

A new Office action (paper # 18) was mailed by the examiner on April 13, 2004; wherein the new Office action stated that applicants' arguments with respect to the claims were moot in view of a new restriction requirement.

An interview summary between the examiner and the attorney of record was conducted on June 7, 2004 (paper # 19). The attorney of record requested a decision on the petition of record and requested consideration as to whether or not the amendment filed with the petition should be entered. The examiner agreed to forward the application to the Director for decision.

OPINION

Petitioner contends that the proposed restriction requirements of January 14, 2003, repeated in the May 15, 2003 Office action; and the new restriction requirement set forth in the April 13, 2004 Office action failed to properly set forth distinctness as set forth in MPEP 800. Further, the petition sets forth reasons why the claims are not distinct in the restriction requirements set forth in paper # 9 and paper # 15.

A review of the record finds that in papers # 9 and # 15, the examiner failed to clearly show how the claims in Groups I through IV are distinct in view of attorney arguments that the claims are not distinct. Furthermore, the Office action mailed April 13, 2004 (paper # 18) is defective inasmuch as the examiner set forth a new restriction requirement but did not allow the applicant to make an election.

CONCLUSION

For the above stated reasons, the petition to withdraw the restriction requirement is **GRANTED**.

The non-final Office action mailed April 13, 2004 is deemed defective for failing to address the restriction requirement and for failing to allow the applicant to make an election and is hereby vacated.

The application file is being forwarded to the Technology Center 2600 technical support staff for entry of the amendment and response filed August 28, 2003. From there, the

application will be forwarded to the examiner for a new and appropriate action in due course.



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